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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,300	02/08/2001	Peter Kwasny	KWASNY-2	4557

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COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

EXAMINER	
REDDICK, MARIE L	
ART UNIT	PAPER NUMBER
1713	7

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/779,300	Applicant(s) KWASNY, PETER	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6 and 7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6 and 7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed 07/30/02 has been entered, considered and found persuasive and therefore deemed sufficient to remove the 112, 1st and 2nd paragraph issues raised in the previous Office Action(paper no. 5, 05/20/02). However, after further consideration and an exhaustive deliberation, prior art of record is deemed pertinent and a rejection based on such is set forth infra. To this end, the indication of allowability is herein regrettably withdrawn. An apology is extended to applicants for any inconvenience that this may have caused.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> **A person shall be entitled to a patent unless –**
>
> **(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

4. Claims 1, 3, 4, 6 & 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0030840(Barrenstein et al),

Barrenstein et al disclose a ready-for-use aerosol derived from a two-component polyurethane lacquer((hydroxyl group-containing acrylic copolymer containing 1 to 7 wt. % of hydroxyl groups and a hardener such as an aliphatic polyisocyanate)) + propellant(propane and/or butane), atomizable from a pressurized container, wherein the acrylic copolymer is

derived from styrene and/or vinyl toluene, esters of (meth)acrylic acid and hydroxyalkyl(meth)acrylates and preferably includes copolymers having the following monomer composition: 40-60 wt.% of styrene, vinyl toluene or methyl methacrylate; 10-50 wt.% of hydroxy ethyl (meth)acrylate, hydroxy propyl (meth)acrylate; 10-50 wt.% of methyl acrylate, ethyl acrylate, butyl acrylate and/or 2-ethylhexyl acrylate and wherein copolymer, in solution, has a general concentration of 30 to 60 wt. %, sufficient to meet the high solid, medium solid and low solid acrylic resin containing OH-groups per claims 1, 4 & 6, wherein the copolymer containing hydroxyl groups dissolved in a solvent together with a propellant is contained in a first pressurized container and the hardener component dissolved in a solvent together with a propellant is contained in a second pressurized container and wherein the "ready-for-use" form is obtained by transfer of one component from its pressurized container into the pressurized container of the second component and the two components are mixed and wherein the contents of the copolymer present in the first pressurized container and of the polyisocyanate present in the second pressurized container are so proportioned that on combination of the two components, a mixture results which contains 60 to 96 wt. % copolymer and 4 to 40 percent of polyisocyanate. See, e.g., the Abstract, page 1, lines 1-14, page 3, lines 12-33, page 4, lines 1-33, page 5, lines 1-21, page 6, lines 1-10, col. 7, lines 7-28, page 8, lines 14-26, page 9, lines 13-32, page 10, lines 1-24 and the Runs of Barrenstein et al. Barrenstein et al therefore anticipate the instantly claimed invention with the understanding that the two-component polyurethane lacquer of Barrenstein et al overlaps in scope with the aerosol preparation per the claimed invention. It is reasonably presumed that the OH-number of the acrylic resin per the claimed invention may be met by the OH group-containing acrylic copolymer per Barrenstein et al since the copolymer is essentially the same as and made in essentially the same manner as the claimed acrylic resin containing OH-groups. It has been held that where applicant claims a composition/component in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the

examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. In re Best, 195 USPQ 430, 433 (CCPA 1977); In re Fitzgerald et al., 205 USPQ 594, 596 (CCPA 1980).

The manner in which the components are combined is immaterial. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind - In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA 1974) - and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. In re Marosi 218 USPQ 290.

As to the dependent claims, the limitations, if not taught or suggested by Barrenstein et al would have been obvious to the skilled artisan and with a reasonable expectation of success.

Even if it turns out that the claims are not anticipated by the disclosure of Barrenstein et al, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Barrenstein et al, the precisely defined aerosol preparation, as claimed, as per such having been within the purview of the general disclosure of Barrenstein et al and with a reasonable expectation of success. Moreover, the use of any commercially available acrylic resin containing OH-groups in lieu of the acrylic copolymer of Barrenstein et al would have been obvious to the skilled artisan and with a reasonable expectation of success.

Conclusion

5. The prior art to Hohlein et al(U.S. 4,382, 114), Hohlein et al(U.S. 4,639,499), Wamprecht et al(U.S. 5,508,337) and JP 01242668 A, listed on the attached FORM PTO 892, are cited as of interest in teaching coating compositions defined basically as containing a polyisocyanate and a polyacrylate polyol governed by an OH number of from 20-300, 20 to 400, 30-155 and 50-150,

respectively. A rejection, in the future, may be made using this prior art. However, since a viable rejection is outstanding on this record, a rejection, based on said art, is not being made at this time. The remainder of the additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
05/20/04